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In re Application of: DANIELL, Henry
U.S. Application No.: 10/520,104
PCT Application No.: PCT/US03/20869
International Filing Date: 02 July 2003
Priority Date: 03 July 2002
Atty Docket No.: 10669-040
For: EXPRESION OF HUMAN
INTERFERON IN TRANSGENIC
CHLOROPLASTS

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(3) AND
37 CFR (a)(6)

This is a decision on the "Petition For Unintentionally Delayed Entry Of A Priority Claim" filed 15 December 2009, treated herein under 37 CFR 1.78(a)(3) and (a)(6). Applicants have paid the required petition fee.

The petition is **DISMISSED** without prejudice.

37 CFR 1.78(a)(3) applies where an applicant seeks to add a delayed claim of benefit under 35 U.S.C. 120 and 365(c) to a prior-filed international application designating the United States or a prior-filed U.S. non-provisional application; 37 CFR 1.78(a)(6) applies where an applicant seeks to add a delayed claim of priority to a prior-filed provisional application. Applicant here is seeking to add priority claims to the prior-filed international application (PCT/US01/06288), U.S. non-provisional applications (09/807,742 and 09/079,640), and U.S. provisional applications (60/185,987, 60/263,473, and 60/263,688) identified in the amendment filed on 07 December 2009. Accordingly, the present petition is properly considered under both 37 CFR 1.78(a)(3) and (a)(6).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). The present non-provisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed applications is submitted after expiration of the periods specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by the following:

- (1) the reference required by 35 U.S.C. 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The present petition fails to satisfy requirement (1).

Specifically, the priority reference contained in the amendment filed 07 December 2009 misidentifies one of the provisional applications for which priority is requested. More specifically, the amendment seeks to add a benefit claim to U.S. provisional application 60/263,688, an application purportedly filed on 23 January 2001 and to which PCT/US01/06288 purportedly claims priority. However, U.S. application 60/263,688 was not filed on 23 January 2001, does not include an inventor in common with the present application, and was not claimed as a priority application in PCT/US01/06288 (it appears that petitioner may have intended to add a claim directed to U.S. provisional application 60/263,668, which was claimed as a priority application in PCT/US01/06288, was filed on 23 January 2001, and names the same inventor as the present application). In view of the inclusion of an incorrect benefit claim, the amendment filed 07 December 2009 is not acceptable in satisfaction of the "reference" requirement of a grantable petition under 37 CFR 1.78(a).

Before the petition under 37 CFR 1.78(a)(3) and (a)(6) can be granted, a renewed petition accompanied by a substitute amendment¹ is required. As discussed above, the substitute amendment must include a revised reference correcting the error in the present amendment with respect to the claim directed to prior-filed provisional application 60/263,688.

Further correspondence with respect to this matter should be addressed as follows:

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¹ Note 37 CFR 1.121

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Any questions concerning this matter may be directed to Richard M. Ross at (571) 272-3296.


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